

### REMARKS

Applicants have carefully reviewed the Office Action mailed August 18, 2005, prior to preparing this response. Currently, claims 32-66 are pending in the application, wherein claims 38-40, 45, 46, 53-55, 60, 61 and 65 are withdrawn from consideration; claims 32-37, 41, 44, 47-52, 56, 59, 62-64 and 66 are rejected; and claims 42, 43, 57 and 58 are objected to as depending from a rejected base claim, but otherwise allowable. Claims 32, 47 and 66 have been amended with this paper. Applicants assert amendments to the claims are supported by the elected species, and no new matter has been added with the amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

The claims are currently under a restriction requirement. As required under 35 U.S.C. §121, Applicants hereby affirm an election to prosecute the invention of the species of Figures 19 and 20, corresponding to claims 32-37, 41, 44, 47-52, 56, 59, 62-64 and 66. This election is made without traverse. Applicants respectfully request consideration of the withdrawn claims upon agreement of an allowable base claim as provided by 37 C.F.R. §1.141.

Claims 42, 43, 57 and 58 are objected to as being dependent upon a rejected base claim, but have been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the favorable consideration of these claims.

Claims 32-37, 41, 44, 47-52, 56, 59, 62-64 and 66 stand rejected under 35 U.S.C. §102(b) as being anticipated by St. Germain et al., U.S. Patent No. 5,534,007 (hereinafter St. Germain). Applicants respectfully traverse this rejection.

Applicants respectfully note "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 32 is directed to a filter retrieval system including a guidewire and a filter coupled to the guidewire. St. Germain at least fails to teach this limitation of the claimed invention.

St. Germain appears to disclose a stent deployment catheter, whereas the currently rejected claims are directed to a filter retrieval system. The Examiner appears to suggest

the stent (35) taught in St. Germain is a filter as currently claimed. Applicants respectfully disagree with this assertion. One of ordinary skill in the art would not equate a stent with a filter. As stated in St. Germain, a stent is an intravascular prosthesis for maintaining vascular patency inside an artery to prevent arterial closure, repair dissection, or prevent restenosis. See St Germain, column 1, lines 30-35. A stent is intended for permanent placement within a vessel and encompasses the outer wall of the vessel, allowing blood to freely flow through. On the other hand, a filter, as currently claimed, is a device capable of extending across a blood vessel lumen for catching embolic material or other debris in the bloodstream. Thus, Applicants assert equating a stent with a filter is unreasonable. Nevertheless, the stent, unlike the filter as currently claimed, is not coupled to the guidewire (20).

For at least these reasons, Applicants assert St. Germain fails to anticipate claim 32. Claims 33-37, 41 and 44 depend from claim 32; therefore, these claims are similarly not anticipated by St. Germain for at least the reasons stated above and because they include additional significant elements. Withdrawal of the rejection is respectfully requested.

Claim 47 recites that the outer diameter of the generally conical tip is slightly smaller than the diameter of the shaft lumen such that the generally conical tip is retractable into the shaft lumen. Support for this limitation may be found, for example, at lines 17-19 of page 28. St. Germain at least appears to fail to teach this limitation of the claimed invention. The distal tip (25) does not appear to be retractable into the lumen of the sheath (40).

For at least these reasons, Applicants assert St. Germain fails to anticipate claim 47. Claims 48-52, 56, 59 and 62-64 depend from claim 47; therefore, these claims are similarly not anticipated by St. Germain for at least the reasons stated above and because they include additional significant elements. Withdrawal of the rejection is respectfully requested.

Claim 66 recites a stop mechanism disposed in a distal portion of the elongate shaft, such that the generally conical tip seats against the stop mechanism upon introducing a filter within the shaft lumen. St. Germain at least appears to fail to teach this limitation of the claimed invention.

For at least these reasons, Applicants assert St. Germain fails to anticipate claim 66. Withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

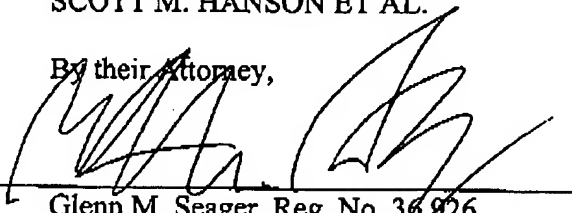
Respectfully submitted,

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By their Attorney,

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